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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/417,251 10/13/99 CAHOON

R BB1085-US-NA

EXAMINER

HM12/0316

E. I. DU PONT DE NEMOURS & CO.  
LEGAL - PATENTS  
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ZARA, J  
ART UNIT

PAPER NUMBER

1635  
DATE MAILED:

03/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/417,251

Applicant(s)

CAHOON ET AL.

Examiner

Jane Zara

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-15 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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### **DETAILED ACTION**

Claims 1-15 are pending in the instant application.

#### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, 14 and 15, drawn to compositions and methods comprising nucleic acids which encode polypeptides, classified in classes 435 and 536, subclasses 6 and 23.1, respectively.
- II. Claim 10, drawn to polypeptides, classified in class 530, subclasses 300 and 350.
- III. Claims 11-13, drawn to methods of selecting polynucleotides that affect levels of polypeptide expression in a plant cell, classified in classes 435 and 536, subclasses 6 and 24.5, respectively.

The inventions are distinct, each from the other because of the following reasons:

The nucleic acids of Group I and the polypeptides of Group II are chemically, biologically, structurally and functionally distinct from each other and thus one does not render the other obvious. The polypeptides of Group II are not required to produce the nucleic acids of Group I, which can be replicated in vectors without use of the protein, and the nucleic acids of Group I are not required to produce the polypeptides of Group II, which can be produced synthetically or isolated from cells. Therefore, the inventions of the two groups are capable of supporting separate patents.

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The products of Groups I and II are biologically and functionally different and distinct from the methods of Group III and thus one does not render the other obvious. The nucleic acids of Group I are not required for the methods of Group III, and the polypeptides of Group II are not required for the methods of Group III. The operation, function and effects of the nucleic acids and polypeptides of Groups I and II are completely different and distinct from the operation, function and effects of the methods of Group III, which identify nucleic acids that affect polypeptide expression in plant cells.

The methods of Group I, drawn to methods of selecting a polynucleotide which encodes a polypeptide in a plant cell, are biologically and functionally different and distinct from the methods of Group III, which are drawn to methods of identifying nucleic acids that affect levels of polypeptide expression in a plant cell, and thus one does not render the other obvious.

Claims 1-15 are drawn to nucleotide and amino acid sequences, nucleotide constructs, and/or methods requiring the use of nucleotide or amino acid sequences or nucleotide constructs that contain more than one individual, independent, and distinct nucleotide or polypeptide sequence in alternative form. Accordingly, these claims are subject to restriction under 35 U.S.C. § 121 as outlined in 1192 O.G. 68 (Nov. 19, 1996).

Applicant is required to select **no more than one** of the individual sequences for examination. The search of no more than one selected sequence may include the complement of the selected sequence and, where appropriate, may include subsequences within the selected sequence (e.g., oligomeric probes and/or primers).

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

### ***Conclusion***

Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jane Zara** whose telephone number is **(703) 306-5820**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader, can be reached on (703) 308-0447. Any inquiry regarding this application should be directed to the patent analyst, Katrina Turner, whose telephone number is (703) 305-3413. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*JZ*

March 12, 2001

  
ANDREW WANG  
PATENT EXAMINER  
TC 1600